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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,309	11/26/2001	Thomas Birkhoelzer	P01,0469	8682
26574	7590	05/23/2006	EXAMINER	
SCHIFF HARDIN, LLP PATENT DEPARTMENT 6600 SEARS TOWER CHICAGO, IL 60606-6473			MOSSER, KATHLEEN MICHELE	
			ART UNIT	PAPER NUMBER
			3715	

DATE MAILED: 05/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/994,309	BIRKHOELZER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Kathleen Mosser	3715	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

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### **DETAILED ACTION**

Prosecution on the merits of this application is reopened on claims 1-6 which are considered unpatentable for the reasons indicated below. A Technology Center Director has approved of reopening prosecution by signing at the end of this action.

### ***Drawings***

1. The drawings are objected to because they including shading or substantially black areas (37 CFR §1.84(m)). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

2. Claim 6 is objected to because of the following informalities: the preamble of the claim refers to "said trainee", there is insufficient antecedent basis for this phrase. Although it is clear that the phrase refers back to the training participant consistent language should be used throughout the claims. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. With regards to claim 1 and its dependents, the claim recites the limitation "a selection device connected to said input device and to said data bank for, in response to, and dependent on, said entry, generating a training unit by combining a number of said training modules taking said dependencies of said training modules on each other into consideration", which is not enabled by the specification. The "selection device" is shown as "black box" in Figure 1 and only described as performing this functionality in the specification. There is no teaching of how such a device is to be physically embodied, how such a device is interfaced with the other components of the system. Although, it may be arguably implied that the device is a software package, or specially programmed computer, the specification makes no mention of the algorithms, rules, guidelines or procedures that such a program would use to make the above determinations. Although it is within the ordinary skill of a computer programmer to write a procedure for making comparisons, the requirements for the programmer to make the determined dependencies, procedures for considering, weighting and taking into consideration those dependencies, and causing the program to output a training regimen based upon such would result in undue experimentation on the part of both the computer programmer and the creator of the body of knowledge. Further the applicant mentions specific attributes which may be used (expert knowledge in claim 2, prerequisites in claim 3, and keywords in claim 4) without teaching how any of these components actually interact with the system. The examples presented in the

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specification only show what training modules will result from an exemplary entry without showing how the system arrives at the results. Similarly the method of claim 6, recites that specific steps are performed. The specification as originally filed does not show how each of these steps is to be achieved, aside from the implication that such is done in a computerized environment.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-4 and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by L'Allier et al (US 6606480 B1). L'Allier et al teaches an apparatus for automatically determining an individually adapted non-prefabricated training unit including: an input device adapted to receive an entry from a training participant (col. 2: 32-40 and 65-67); a data bank in which a plurality of training modules are stored, said training modules having dependencies on each other and said dependencies also being stored in said data bank (Figure 9); and a selection device connected to said input device and to said data bank for, in response to, and dependent on, said entry, generating a training unit (referred to as an individual development plan or individualized learning sequence by L'Allier et al) by combining a number of said training modules taking said dependencies of said training modules on each other into consideration (the gap analysis software, col. 5: 28-58), as in claim 1. Each of the training modules having a content with an expert knowledge level (skill level) associated therewith and the selection unit generating the training unit from training modules respectively having uniform levels of expert knowledge associated therewith (claim 2) is shown in at least col. 5: 35-40. Each of the modules having a content, and the content of some

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modules being a prerequisite for the content of other modules, wherein the selection device take said prerequisite content into consideration in generating said training unit (claim 3) is shown in at least col. 5: 41-48. The input device allowing for the entry of keywords, wherein the key words are stored in the data bank, and wherein the selection device generates the training unit based on the key words (claim 4) is shown in at least col. 7: 26-67.

L'Allier et al further teaches a method for automatically determining learning needs of a training participant and defining a customized training unit for the trainee including: entering into a computerized system, an entry characterizing learning needs of a training participant including learning objectives of a training participant (desired skill level), background knowledge of a training participant (current skill level), and a requested topic (the area the skill is in), see col. 6: 6-20; from among a plurality of training modules stored in said computerized system, determining all training modules responsive to said entry (col. 5: 27-39); from among said training modules responsive to said entry, identifying selected training modules, dependent on said background knowledge (col. 5: 41-48); and defining a training unit customized to said participant from multiple training modules identified in the above steps (col. 5: 52-58), as recited in claim 6.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

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3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over L'Allier et al (US 6606480 B1). L'Allier et al teaches all aspects of the claimed invention as shown above, but fails to specifically teach that the data bank contains a plurality of medical education training modules as said training modules. The examiner notes that L'Allier et al is not specifically drawn to any field education. Modifying a system to include a specific field of educational material is considered well within the level of one of ordinary skill in the art of teaching, and would only require the compilation of materials related to such. Further the specific content stored in a memory constitutes "printed matter" in the sense that is merely an arrangement of indicia. As L'Allier et al discloses the claimed invention except for the specific arrangement and /or content of indicia (printed matter) set-forth in the claim(s). It would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the content to include medical training data, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. In re Gulack, 217 USPZ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of training it does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter e.g. the medical training data and the substrate e.g. the data bank which is required for patentability.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


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- a. Ho et al (US 5863208,, 6126448, 5727951, 5934909) teach a variety of procedures for making determinations of individual training needs based upon a hierarchy of knowledge

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen Mosser whose telephone number is (571) 272-4435. The examiner can normally be reached on M-F 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (571) 272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Kathleen Mosser  
Primary Examiner  
Art Unit 3715

May 17, 2006



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